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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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28914	7590	06/24/2004	EXAMINER	
LAW OFFICES OF DONALD COX 40 NASSAU ST PRINCETON, NJ 08542-4522			BROCKETTI, JULIE K	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,032

Applicant(s)

KELLEN, WILLIAM G.

Examiner

Julie K Brockett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12, 20 and 22 of U.S. Patent No. 6,645,072 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose identical subject matter such as an electronic game apparatus comprising memory, a user interface, a central processing unit, etc. for use in the game of bingo.

Claim Objections

Claims 3, 4, 6 and 17-20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

As discussed below, all of these claims depend from parent claims that are apparatus claims and therefore do not further limit their parent claims as they described only functions and uses for the parent claims and do not add additional structure or limitation to the parent claims.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

There are two claim 12s and 13s. Misnumbered claims 12-20 been renumbered as claims 14-22. Applicant is advised to renumber the claims himself when responding to the Office Action. Furthermore, clarification on which claim 12 the second claim 13 is based is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "game pieces". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Birenbaum et al., U.S. Patent No. 4,768,151. Birenbaum discloses an electronic game apparatus. Memory is used and is adapted to store bingo rules for at least one round of bingo, a plurality of bingo cards and an identifier for the number of bingo cards in play (See Birenbaum col. 3 lines 40-48; col. 4 lines 9-12). A user interface includes a display adapted to display

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a bingo card and a keypad configured for entry of bingo numbers (See Birenbaum Fig. 1). A central processing unit is adapted under the control of software to markup/daub the bingo cards in play during a bingo game according to the bingo rules in response to entry of bingo numbers using a keypad. The user is provided through the user interface with at least one of the bingo cards in play. The bingo card provided to the user interface is selected by the central processing unit as being most likely to win the round of bingo (See Birenbaum col. 3 lines 41-67; col. 4 lines 1-52) [claims 1, 18, 19]. Birenbaum has a first memory location adapted to permanently storing a plurality of bingo cards (See Birenbaum Fig. 3, item 52). The processor is adapted under the control of software to select at least one bingo card from said plurality of bingo cards; wherein said processor selects said at least one bingo card according to a selection rule independent of the user, i.e. without user input (See Birenbaum col. 4 lines 45-52) [claims 2, 20, 22]. The Examiner notes that much of the above cited limitations are intended use but Birenbaum does teach of the same intended use as disclosed by Applicant. The limitations of wherein the selection rule is to select bingo cards randomly [claims 3, 21] and wherein the processor selects bingo cards equivalent to a quantity purchased for each round of bingo [claim 4] are intended use limitations and not structural. Furthermore, Birenbaum is capable of performing the limitations. Birenbaum further discloses a second memory location that is adapted to store at least one identifier for a quantity of bingo cards in play

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during at least one round of bingo and the processor selects bingo cards in quantities equivalent to said at least one identifier (See Birenbaum Fig. 3, items 44 and 46) [claim 5]. The limitation of wherein a bingo hall operator defines the selection rule [claim 6] is an intended use limitation and not structural. Furthermore, Birenbaum is capable of performing the limitation. The apparatus includes a removable memory (See Birenbaum Fig. 1, item 14) [claim 7]. The removable memory includes game information for playing at least one round of bingo (See Birenbaum col. 3 lines 50-67). The Examiner also notes that all phrases after the words “adapted to...” in the claims are intended use limitations and even though Birenbaum may disclose some of these limitations, it is not necessary that Birenbaum disclose them.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation *Ex parte Masham*, 2 USPQ2d 1647 (1987). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, in the structural claim dictated by claims 1-6, 15 and 18-22 is capable of being used in a different manner that would not result in a

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structural difference, only a difference of a software program executed by the respective processors. Hence the recitation that the device be employed in a specific manner regarding the actions of the structure does not differentiate the claimed apparatus from the Birenbaum et al. apparatus, which satisfies the claimed structural limitation and some of the intended uses for the device.

Additionally, the Applicant is invited to review MPEP §2114 R-1 which states:

MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Additionally, the MPEP §2114 R-1 clarifies that an apparatus claim is drawn to the structure of the device, not the function, by stating “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Regarding claims 1-6, 15 and 18-22, the claims are intended use as discussed above. The Examiner invites the Applicant to review MPEP §2106 II-C which states: The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a

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claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or *does not limit a claim to a particular structure does not limit the scope of a claim* or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

This list of examples is not intended to be exhaustive.

In particular as in claims 3, 4, 6 and 17-20, when such intended use and wherein clauses are used within a structural claim, they do not further limit the claim to a particular structure and therefore do not limit the scope of the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birenbaum et al., U.S. Patent No. 4,768,151.

Birenbaum discloses that the removable memory includes game information. However, Birenbaum lacks in specifically disclosing that the removable memory contains rules for at least one round of bingo or a record of how many bingo cards are to be used in at least one round of bingo. Birenbaum does disclose that the rules for at least one round of bingo are stored in the memory on the circuit board of the apparatus (See Birenbaum col. 4 lines 9-12) [claim 9]. Furthermore the game information stored in the memory of the apparatus of Birenbaum includes a record of how many bingo cards are to be used for at least one round of bingo (See Birenbaum col. 3 lines 43-46) [claim 10]. It therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to include the rules for bingo and a record of the cards used for play in the removable memory of Birenbaum. By storing this data in the removable memory, more memory on the main circuit board is freed up. Therefore, a player can store more information externally from the apparatus.

Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birenbaum et al., in view of Fisher, U.S. Patent No. 4,480,180. Birenbaum discloses an electronic game apparatus. A processor is under the control of software for playing at least one round of a game of chance. A user interface is provided. A housing is provided for the processor. A removable memory cartridge includes information about the game of chance

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and is securely engaged in the housing (See Birenbaum Figs. 1 & 3) [claim 11].

Birenbaum discloses that the removable memory includes game information.

However, Birenbaum lacks in specifically disclosing that the removable memory contains rules for at least one round of bingo or a record of how many bingo

cards are to be used in at least one round of bingo. Birenbaum does disclose

that the rules for at least one round of bingo are stored in the memory on the circuit board of the apparatus (See Birenbaum col. 4 lines 9-12) [claim 12].

Furthermore the game information stored in the memory of the apparatus of Birenbaum includes a record of how many bingo cards are to be used for at

least one round of bingo (See Birenbaum col. 3 lines 43-46) [claim 13]. It

therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to include the rules for bingo and a record of the cards

used for play in the removable memory of Birenbaum. By storing this data in the removable memory, more memory on the main circuit board is freed up.

Therefore, a player can store more information externally from the apparatus.

Birenbaum further discloses that the housing is adapted to be stackable upon other like housings (See Birenbaum Fig. 1) [claim 14]. The housing includes a

handle for carrying the apparatus (See Birenbaum Fig. 1) [claim 16]. The

handle is adapted to adjust to a supporting position to hold the housing in a generally upright position (See Birenbaum col. 2 lines 67-68) [claim 17]. The

housing includes a first surface having at least one ridge and a second surface having at least one recess wherein a plurality of housings may be stacked by

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positioning the at least one ridge of the first surface in contact with the at least one recess of the second surface (See Birenbaum Fig. 1) [claim 15]. Birenbaum lacks in disclosing a release key. Fisher teaches of a release key for a removable cartridge (See Fisher Figs. 1-5; col. 4 lines 8-19) [claim 11]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a release key for removing the removable cartridge in the invention of Birenbaum. By having a release key, the cartridge cannot be removed at any time or accidentally. Therefore only someone with the key can remove the cartridge, which provides additional security for the game.

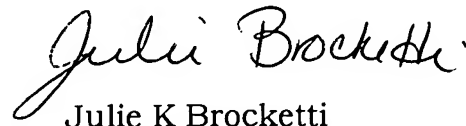
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 703-308-7306. The examiner can normally be reached on M-Th 7:30-5:00.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julie K Brockett
Examiner
Art Unit 3713